

REMARKS

Claims 1-3, 6-22, 25-28 and 30-40 are pending in this application. By this Amendment, claims 1, 16, 20, 21, 28, 30 and 38 are amended. No new matter is added. Reconsideration of the application is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration because the amendments are merely to correct an informality and dependency and for better clarity; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because such amendments were discussed and suggested by the Examiner during the October 26 personal interview. Entry of the amendments is thus respectfully requested.

Applicants thank Examiner Stork for the courtesies extended to Applicants' representatives during the October 26, 2005 personal interview. During the interview, Applicants' representatives and Examiner Stork discussed claim language to overcome the rejections. Finality of action was also discussed.

I. Finality is improper

The Office Action makes the first action final. The April 27 Advisory Action stated that the April 6, 2005 affidavit was not entered because a showing of good and sufficient reasons why the affidavit was necessary and was not earlier presented was not provided and would require further search and/or consideration. As discussed in the June 10 Request for Reconsideration, Examiner Stork indicated during the May 5, 2005 telephone interview that the April 6 affidavit was deficient. In response, Applicants filed a Request for Continued Examination on June 10, 2005 with a revised affidavit, for which Applicants attempted to

overcome the deficiency, including information that had not been presented in the previous affidavits.

MEPE §706.07(b) clearly states that it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because new issues were raised that required further consideration and/or search. The RCE was filed to allow the Examiner to properly consider the affidavit that was denied for entry.

The August 11 Final Rejection provides an explanation why the June 10 affidavit is deficient, including result of the Examiner's consideration of the June 10 affidavit (see item 2 on page 2 of the Final Rejection, which states "The declaration filed on 10 June 2005 under 37 CFR 1.131 has been considered..."). This confirms that the Patent Office acknowledged the June 10 RCE and properly considered the June 10 affidavit in view of the June 10 RCE.

During the October 26 personal interview, Examiner Stork asserted that the finality is proper because the further consideration and/or search would have been necessary if the affidavit had been entered, as the affidavit would have disqualified one of the applied references. However, Applicants respectfully submit that the finality of action in this particular circumstance involves the entry of the affidavit, not what if the affidavit had been entered.

Accordingly, this first action Final Rejection is improper. As such, withdrawal of the finality of action is respectfully requested.

II. Formal Matters

Claims 28 and 30 are amended to correct informalities, and thus such amendments do not affect the patentability of these claims, and therefore, not narrowing the claim scope.

III. Prior Art Rejections

Claims 1-3, 6, 7, 9-12 and 16-19 are rejected under 35 U.S.C. §103(a) over "Document thumbnail visualizations for rapid relevance judgments: Where do they pay off?" by Ogden et al. (Ogden) in view of U.S. Patent Application Publication No. 2003/0006995 to Smith et al. (Smith). This rejection is respectfully traversed.

Claim 1 recites, *inter alia*, that modifying the apparatus of the at least one visible element comprises automatically overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element based on importance of the at least one visible element.

As discussed during the interview, the overlaying is performed automatically, i.e., without user control, based on importance of the at least one visible element. For example, as described at paragraph [0045] of the specification, important elements are extracted by an element extractor 2222. Important elements may be or include a document header, words that match keywords input by a search request, words or other information associated with tags, and/or elements indicated to be relevant by a relevance determination system 2228. Then, as described at paragraph [0064], for example, an image modifier 226 transforms the important element identified by the element extractor 2222. As described at paragraph [0065], the identified important element is enlarged and graphically overlaid on top of a thumbnail by a callout generator 2262. This allows the user to more easily recognize the important element in the thumbnail. This process modifying the important element and graphically overlaying the important element on top of the thumbnail based on the importance of a visible element is performed without user control or input.

As agreed during the interview, Smith requires the user to manipulate the magnifier to magnify a certain parts of a document. Moreover, Smith only teaches to magnify certain parts of the document as specified by the user. In other words, the magnification does not occur

automatically based on the importance of a visible element. Therefore, Applicants respectfully submit that even if Ogden and Smith are combined, they do not teach or suggest each and every feature of claim 1, and therefore, claim 1 is patentable over the applied references.

Claims 2, 3, 6, 7, 9-12 and 19 are patentable at least for their dependence on claim 1, as well as for the additional features they recite.

Claim 16 recites modifying an appearance of at least one of a plurality of elements in a reduced-size representation after generating the reduced-size representation by automatically overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element based on importance of the visible element.

Similar to claim 1, Ogden and Smith do not teach or suggest these features. As such, Applicants respectfully submit that claim 16 is patentable over the applied references.

Claims 17 and 18 are patentable at least for their dependence on claim 16, as well as for the additional features they recite.

At least for these reasons, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claim 13 under 35 U.S.C. §103(a) over Ogden and Smith in view of "Perceptual Thumbnail" by Chiou et al (Chiou). This rejection is respectfully traversed.

Chiou does not overcome the deficiencies of Ogden and Smith discussed above with respect to claim 1. Therefore, claim 13 is patentable at least for its dependence on claim 1, as well as for the additional features it recites. As such, withdrawal of the rejection is respectfully requested.

The Office Action rejects claims 21-30 and 34-42 under 35 U.S.C. §103(a) over Ogden and Smith in view of U.S. Patent No. 6,275,829 to Angiulo et al. (Angiulo). This rejection is respectfully traversed.

Claim 21 recites, *inter alia*, that the document format modifier modifies the appearance of the at least one visible element in the reduced-size representation by automatically overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element based on importance of the visible element.

Similar to claim 1, Ogden and Smith do not teach or suggest these features. Angiulo does not overcome this deficiency of Ogden and Smith. As such, Applicants respectfully submit that claim 21 is patentable over the applied references.

Claim 28 recites an image modifier modifies the appearance of the important element by automatically overlaying a modified version of the important element on or near the reduced-size representation based on importance of the visible element.

Similar to claim 1, Ogden and Smith do not teach or suggest these features. Angiulo does not overcome the deficiency of Ogden and Smith. As such, Applicants respectfully submit that claim 28 is patentable over the applied references.

Claims 22, 25-27, and 30-40 are patentable at least for their dependence on claims 21 and 28, as well as for the additional features they recite.

The rejection of claims canceled 23, 24, 29, 41 and 42 is moot.

The Office Action rejects claim 31 under 35 U.S.C. §103(a) over Ogden, Smith and Angiulo further in view of Chiou. This rejection is respectfully traversed.

Chiou does not overcome the deficiencies of Ogden, Smith and Angiulo above with respect to claim 21. Therefore, claim 31 is patentable at least for its dependence on claim 21, as well as for the additional features it recites. As such, withdrawal of the rejection is respectfully requested.

The Office Action rejects claims 32 and 33 under 35 U.S.C. §103(a) over Ogden, Smith, Angiulo, and Chiou further in view of U.S. Patent No. 6,708,309 to Blumberg et al. (Blumberg). This rejection is respectfully traversed.

Blumberg does not overcome the deficiencies of Ogden, Smith, Angiulo and Chiou discussed above. Therefore, claims 32 and 33 are patentable at least for their dependence on claim 21, as well as for the additional features it recites. As such, withdrawal of the rejection is respectfully requested.

The Office Action rejects claims 8 and 20 under 35 U.S.C. §103(a) over Ogden and Smith further in view of U.S. Patent Application Publication No. 2002/0167534 to Burke. Burke does not overcome the deficiencies of Ogden and Smith discussed above with respect to claim 1. Therefore, claim 8 is patentable at least for its dependence on claim 1, as well as for the additional features it recites.

Claim 20 recites modifying an appearance of the at least one important element relative to other elements of the plurality of elements in the reduced-size representation by automatically overlaying a semi-transparent modified version of the important element on or near the reduced-size representation that allows the underlying portion of the reduced-size representation to be partially visible based on importance of the visible element.

Similar to claim 1, Ogden and Smith do not teach or suggest this feature. Burke does not overcome the deficiencies of Ogden and Smith. As such, claim 20 is patentable over the applied references.

In addition, as discussed during the interview, Applicants respectfully disagree with the alleged modification of Smith in view of the teachings of Burke. That is, the Office Action alleges that one of ordinary skill in the art would have been motivated to combine Burke with Ogden and Smith to allow a user to make reading of desired portions of text easier. However, as described at paragraph [0022], Burke teaches overlaying so that the text or display area of interest is highlighted (i.e., not covered by the overlay) so as to direct user's attention to it. In other words, Burke teaches applying overlays in non-important areas in the display. On the other hand, Smith overlays a magnifier on top of a certain section of a

document that is of interest to the user (e.g., selected). A person skilled in the art combining the teachings of Burke with Smith would result in overlaying the areas not magnified by the magnifier of Smith, that is, covering the unimportant areas. Therefore, one of ordinary skill in the art would not have been motivated to modify Smith as suggested by the Office Action. Applicants respectfully submit that modifying Smith in view of Burke as alleged by the Office Action necessarily relies on impermissible hindsight gained from Applicants' disclosure, which is improper.

At least for these reasons, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 30 and 38 under 35 U.S.C. §103(a) over Ogden, Smith and Angiulo further in view of Burke. This rejection is respectfully traversed.

Burke does not overcome the deficiencies of Ogden, Smith and Angiulo discussed above with respect to claim 28. As such, claim 30 is patentable at least for its dependence on claim 28.

Claim 38 recites, *inter alia*, that at least one important element is modified by automatically overlaying a semi-transparent modified version of the at least one important element on or near the reduced size representation based on importance of the visible element.

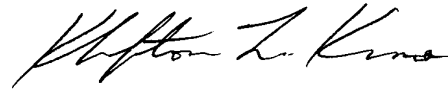
Similar to claim 20, none of the applied references teach or suggest this feature. As such, Applicants respectfully submit that claim 38 is patentable over the applied references.

At least for these reasons, Applicants respectfully request withdrawal of the rejection.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: November 9, 2005

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